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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,235	08/26/2003	William B. McClure	1924/US/2	6207
20686	7590	08/31/2006	EXAMINER	
DORSEY & WHITNEY, LLP INTELLECTUAL PROPERTY DEPARTMENT 370 SEVENTEENTH STREET SUITE 4700 DENVER, CO 80202-5647			PYO, MONICA M	
			ART UNIT	PAPER NUMBER
			2161	
DATE MAILED: 08/31/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/649,235	MCCLURE, WILLIAM B.	
	Examiner	Art Unit	
	Monica M. Pyo	2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is responsive to the Amendment filed 5/30/2006.
2. Claims 1-16 are currently pending in this application. Claims 1 and 8 are independent claims. In the Amendment filed 5/30/2006, claim 1 is amended. This action is made Final.

Specification

3. Claim 1 is objected to because of the following informalities:

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

Regarding claim 1, this claim recites the limitation “generating a form” (in line 2), “generating a unique identifier as part of generating the form”(in line 3), “after printing... scanning the form” (in line 5). The specification does not provide proper antecedent basis for above claim limitations (i.e., [0007], lns. 2-3; [0009], lns. 3-5; [0021], lns. 14-15 only teaches the generation of unique document identifier, not “generating a form” limitation). Applicant is required to disclose the location that teaches above newly added limitations.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 8-9 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,427,032 issued to Irons et al. (hereafter Irons).

Regarding Claim 8, Irons discloses an apparatus for managing form-based records, comprising:

- **an input device**, as a computer (Irons: col. 7, lns. 52-62; col. 8, lns. 10-15; col. 10, lns. 40-60; figs. 1 & 2);
- **a web browser operatively connected to the input device**, as a computer containing a web browser (Irons: col. 11, lns. 16-23 & 38-44; fig. 2);
- **a database searchable by the web browser and storing at least one form-based record**, as a utilization of a digital filing application for searching and retrieval (Irons: col. 11, lns. 60-67; col. 12, lns. 1-12; col. 16, lns. 49-65);
- **a display device operatively connected to the web browser and database, the display device operative to display the at least one form-based record**, as an image being viewed by a web browser (Irons: col. 11, lns. 4-15; col. 12, lns. 24-39; col. 28, lns. 60-67; figs. 2 & 13);
- **a printer operatively connected to the web browser and input device**, as a printer 310 being connected to the computer 200, which includes the web browser and also connected to an input device (Irons: col. 12, lns. 48-59; col. 18, lns. 52-57; figs. 1, 2 and 3);
- **a scanner operatively connected to the database**, as a device capable of scanning (Irons: col. 7, lns. 52-60; col. 8, lns. 1-15; fig. 1); and
- **a remote storage location driver operative to display a remote storage location as a local output device, the remote storage location driver**

operatively connected to the web browser and database, as an image index database capable of storing information and may each database be stored at different remote location (Irons: col. 12, lns. 12-45; col. 17, lns. 9-18; col. 23, lns. 23-38).

Regarding Claim 9, Irons discloses the apparatus further comprising:

- an input device operatively connected to the database (Irons: col. 7, lns. 52-62; col. 8, lns. 10-15; col. 10, lns. 40-60; figs. 1 & 2); and
- an input recognition module operatively connected to the input device, the input recognition module operative to identify a file on a storage medium within the input device and copy the file to the database (Irons: col. 12, lns. 3-12; col. 16, lns. 41-58; figs. 2 & 7).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Irons in view of U.S. Patent No. 7,016,901 (hereafter Eikenbery).

Regarding Claim 1, Irons discloses a method for managing form-based records comprising:

- **printing the form including the unique identifier**, as a printer printing the globally unique document identifier directly onto the document (Irons: col. 8, lns. 50-60; col. 29, lns. 35-45; fig. 14 – fig. 14 illustrates a form 1450 printed with text and a label 1451 on a document)
- **after printing the form including the unique identifier, scanning the form to capture information including the unique identifier**, as the paper-based document is subsequently scanned with the globally unique identification (Irons: col. 8, lns. 50-60; col. 9, lns. 5-9)
- **storing the information as a record in a database**, as the information is stored in a record in an image repository (Irons: col. 9, lns. 10-18); and
- **indexing the record by the unique identifier**, as the system coordinates to index a globally unique image document identifier (Irons: col. 8, lns. 30-54; col. 9, lns. 10-18) .

Irons does not explicitly disclose:

- **generating a form;**
- **generating a unique identifier as part of generating the form;**

However, Eikenbery discloses:

- **generating a form**, as a generation of a drawing file (Eikenbery: col. 4, lns. 59- col. 5, lns. 4);
- **generating a unique identifier as part of generating the form**, as the process to acquire the pertinent identification after generating an electronic version (Eikenbery: col. 6, lns. 6-16)

It would have been obvious to a person with ordinary skill in the art at the time of invention to combine this electronic form distribution management of Eikenbery into the unique identification labeling of Irons. Skilled artisan would have been motivated to incorporate the Eikenbery's teaching of managing a distributed database of electronic files in the Iron's unique identification labeling to enhance the management of electronic forms in databases (Eikenbery: col. 1, lns. 22-29).

8. Claims 2-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Irons in view of Eikenbery as applied to claim 1, and further in view of U.S. Patent Application Publication No. 2002/0073085 by O'Day, JR. et al. (hereafter O'Day).

Regarding Claim 2, Although Irons and Eikenbery are silent about "synchronizing" between two databases, Irons and Eikenbery do disclose an "automatic backup" (Irons: col. 17, lns. 14-19). Yet, Irons and Eikenbery do not explicitly disclose the method further comprising the operation of synchronizing the database with a remote database.

However, O'Day discloses: synchronizing the database with a remote database (O'Day: pg. 5, [0053]).

It would have been obvious to a person with ordinary skill in the art at the time of invention to combine this synchronization of O'Day into the electronic form distribution management of Eikenbery and the unique identification labeling of Irons. Skilled artisan would have been motivated to incorporate the O'Day's teaching of synchronizing central and remote databases in the Eikenbery's teaching of managing a distributed database of electronic files and

the Iron's unique identification labeling in view of enhancing real time update (O'Day: pg. 5, [0053]).

Regarding Claim 3, Irons and Eikenbery and O'Day disclose the method wherein the operation of synchronizing the database with a remote database comprises copying the information from the database to the remote database (O'Day: pg. 5, [0053]).

Regarding Claim 4, Irons and Eikenbery and O'Day disclose the method wherein the operation of synchronizing the database with a remote database comprises copying the information from the remote database to the database (O'Day: pg. 5, [0053]).

Regarding Claim 5, Irons and Eikenbery and O'Day disclose the method further comprising the operation of selecting a form from the remote database (Irons: col. 18, lns. 40-52).

Regarding Claim 6, Irons and Eikenbery and O'Day disclose the method further comprising the operation of presenting the remote database as a local output device (O'Day: col. 12, lns. 47-55; col. 23, lns. 23-38).

9. Claims 10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Irons as applied to claims 8-9, in view of U.S. Patent Application Publication No. 2002/0073085 by O'Day, JR. et al. (hereafter O'Day).

Regarding Claim 10, Irons discloses the apparatus further comprising:

- a remote storage location operatively connected to the remote storage location driver (Irons: col. 8, lns. 16-29; col. 9, lns. 19-38; col. 10, lns. 13-31; fig. 1); and
- a remote database resident on the remote storage location (Irons: col. 9, lns. 19-38),

However, Irons does not explicitly disclose: the remote database accepting files from the database.

However, O'Day discloses: the remote database accepting files from the database (O'Day: pg. 5, [0053]).

It would have been obvious to a person with ordinary skill in the art at the time of invention to combine this synchronization of O'Day into the unique identification labeling of Irons to accomplish synchronization of two databases. Skilled artisan would have been motivated to incorporate the O'Day's teaching of synchronizing central and remote databases in the Iron's unique identification labeling in view of enhancing, real time update as suggested by O'Day, which discloses "the portion of the central database 64 to which a user has access and the remote database 94 on the user's remote computer 24 contain the same primary information" (O'Day: pg. 5, [0053]).

Regarding Claim 11, Irons and O'Day disclose the apparatus wherein the remote database accepts files from the database continuously (O'Day: pg. 7, [0073] – Although O'Day is silent about disclosing a term "continuously", the step 435 performs without user control to

upload files to activate either steps 440 or 445).

Regarding Claim 12, Irons and O'Day disclose the apparatus wherein the remote database accepts files from the database at predetermined times (O'Day: pg. 5, [0053]; pg. 8, [0078]).

Regarding Claim 13, Irons and O'Day disclose the apparatus wherein the database accepts files from the remote database (O'Day: pg. 5, [0053]).

Regarding Claim 14, Irons and O'Day disclose the apparatus further comprising a unique document identifier generation module operatively connected to the database, the unique document identifier generation module operative to generate a unique document identifier corresponding to the at least one form-based record (Irons: col. 7, lns. 12-17; col. 8, lns. 37-42; col. 19, lns. 8-26 & 33-43; figs. 1, 3 and 7a.)

Regarding Claim 15, Irons in view of O'Day discloses the apparatus further comprising:

- a unique apparatus identifier (Irons: col. 7, lns. 13-33; figs. 1, 3 & 3a); and wherein
- the unique document identifier is at least partially based on the unique apparatus identifier (Irons: col. 12, lns. 48-55; fig. 3-3e); and
- the at least one form-based record is indexed in the database by the unique document identifier (Irons: col. 8, lns. 30-49; fig. 1).

10. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Irons in view of Eikenbery, further in view of O'Day as applied to claims 2-6, and further in view of U.S. Patent Application Publication No. 2004/0260569 by Bell et al. (hereafter Bell).

Regarding Claim 7, although Irons and Eikenbery and O'Day do not specifically disclose a non-network printer, Irons and Eikenbery and O'Day disclose the local output device is a local (Irons: col. 12, lns. 55-59 – Irons discloses a “desktop label printer” as a “local” printer).

However, Bell specifically discloses: non-network printer (Bell: pg. 9, [0073]).

It would have been obvious to a person with ordinary skill in the art at the time of invention to combine this local printer of Bell into the synchronization of O'Day into the electronic form distribution management of Eikenbery and the unique identification labeling of Irons. Skilled artisan would have been motivated to incorporate the Bell's teaching of local printer example in the O'Day's teaching of synchronizing central and remote databases and the Eikenbery's teaching of managing a distributed database of electronic files, and the Iron's unique identification labeling to achieve printing without a network connection (Bell: pg. 9, [0073]).

11. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Irons in view of O'Day as applied to claims 10-15, and further in view of U.S. Patent No. 6,651,218 issued to Adler et al. (hereafter Adler).

Regarding Claim 16, Irons and O'Day disclose the apparatus wherein the unique document identifier (Irons: col. 7, lns. 13-33; figs. 1, 3 & 3a)

Irons and O'Day does not disclose: a DataGlyph.

However, Adler discloses an example of reading pre-printed one or two-dimensional data codes, which is: a DataGlyph (Adler: col. 3, lns. 41-55).

It would have been obvious to a person with ordinary skill in the art at the time of invention to combine this DataGlyph of Adler into the unique identification labeling of Irons to make marks on papers. Skilled artisan would have been motivated to incorporate the Adler's teaching of DataGlyph example in the Iron's unique identification labeling to provide secure labeling on a document as suggested by Adler, which discloses "identifying the genre to which the document belongs, locating at least one significant data item within the document (based on its genre), and extracting and storing each data item in a database" (Adler: see Abstract; col. 4, lns. 47-54).

Response to Arguments

12. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

Regarding claim 8, applicant argues that Irons fails to teach "a remote storage location driver operative to display a remote storage location as a local output device, the remote storage location driver operatively connected to the web browser and database." However, the Examiner disagrees. Irons discloses in col. 23, lns. 23-38 that the imaging engines already being used by web browsers for viewing images can be used to provide on-screen visual representations for the imaged documents. Additionally, Irons discloses the network storage device in col. 17, lns. 6-19

and different remote locations for storing in col. 12, lns. 12-23. Thus, Irons discloses what has been claimed and therefore reads on the applicant's broadly claimed limitations.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica M. Pyo whose telephone number is 571-272-8192. The examiner can normally be reached on Mon-Fri 6:30 - 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Monica M Pyo
Examiner
Art Unit 2161

12/29/2006

Leslie Wong
Primary Examiner